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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,471	12/10/2001	Ichiro Kajitani	062077	4574

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EXAMINER

TOPGYAL, GELEK W

ART UNIT PAPER NUMBER

2621

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,471	Applicant(s) KAJITANI, ICHIRO	
	Examiner Gelek Topgyal	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 September 2006.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 December 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/15/2002 have been fully considered but they are not persuasive.
2. In re pages 2-4, the applicant argues with respect to independent claim 1, the locations of the user and system, including: 1) location of the "program recording system" of claim 1 is within the "user's domain" separate from a broadcasting station or server and doesn't include constituting elements in the public domain (pg. 2), 2) Similarly, argues that the system of the present application is located in the personal domain within a home (pg. 3).

In response, the examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "**broadcasting station**", "**server**", "**public domain within a home**") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. In re paragraph connecting pages 2 and 3, the applicant argues with respect to independent claim 1 that Girard et al. allows recording of programs that are currently being broadcast in a server as a reserve of past programs without requiring a user to record the program.

In response to applicant's arguments against the references individually (Girard et al.), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, Girard et al. is not relied to teach the limitations that the applicant argues.

4. In re pages 3-4, the applicant argues with respect to independent claim 1, Girard et al. does not teach the ability to capture at least one scene of a program according to the confirmation request.

In response, the examiner respectfully disagrees. As taught by Girard et al. the preview clips are stored on the continuous media server. The claim language for "capturing" can be broadly interpreted as having the ability "**to obtain**" (as per the Merriam Webster dictionary). Therefore, when Girard et al.'s system receives a confirmation request, the preview clip (at least one scene of a program that is currently broadcast) **is obtained from the server** (captured) and put on the transmission media and delivered to the user. Therefore, a capturing unit "captures at least one scene of the program according to the confirmation request" is taught by Girard et al.

5. In re page 4, the applicant argues that independent claim 2 should be allowable for the same arguments as presented for independent claim 1.

In response, the examiner respectfully disagrees. Independent claim 1 has been rejected as discussed in paragraphs 2-4, above; therefore, independent claim 2 is rejected for the same reasons.

6. In re pages 4-5, the applicant argues that dependent claims 3-9 should be allowable for being dependent on independent claims 1 or 2 directly or indirectly.

In response, the examiner respectfully disagrees. Independent claims 1 and 2 have been rejected as discussed in paragraphs 2-5, above, therefore, dependent claims 3-9 also remain rejected.

7. In re page 5, the applicant argues that independent claim 10 should be allowable for the same arguments as presented for independent claim 2.

In response, the examiner respectfully disagrees. Independent claim 2 has been rejected as discussed above in paragraphs 2-5; therefore, independent claim 10 is rejected for the same reasons.

8. In re page 6, the applicant argues that dependent claims 11-12 should be allowable for being dependent on independent claim 10.

In response, the examiner respectfully disagrees. Independent claim 10 has been rejected as discussed in paragraph 7, above, therefore, dependent claims 3-9 also remain rejected.

9. In re page 6, the applicant argues that independent claim 13 should be allowable for the same arguments as presented for independent claim 2.

In response, the examiner respectfully disagrees. Independent claim 2 has been rejected as discussed above in paragraphs 2-5; therefore, independent claim 13 is rejected for the same reasons.

10. In re page 7, the applicant argues that dependent claim 14 should be allowable for being dependent on independent claim 13.

In response, the examiner respectfully disagrees. Independent claim 13 has been rejected as discussed in paragraph 9, above; therefore, dependent claim 14 also remains rejected.

11. In re page 7, the applicant argues that independent claim 15 should be allowable for the same arguments as presented for independent claim 2.

In response, the examiner respectfully disagrees. Independent claim 2 has been rejected as discussed above in paragraphs 2-5; therefore, independent claim 15 is rejected for the same reasons.

12. In re page 7, the applicant argues that dependent claim 16 should be allowable for being dependent on independent claim 15.

In response, the examiner respectfully disagrees. Independent claim 15 has been rejected as discussed in paragraph 9, above; therefore, dependent claim 15 also remains rejected.

The previous Office Action has been copied below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani (US 7,028,329) in view of Girard et al. (US 5,571,282).

Regarding claim 1, Mizutani teaches a remote accessible programming system Which teaches a confirmation request receiving unit, which receives a request for confirmation of contents of a program this is being broadcast, from a remote user (Figs. 1-7, col. 5, lines 34 - col. 7, line 3, recites wherein a remote user is able to retrieve a list of scheduled broadcast programs from the server 15); a recording request receiving unit which receives a request for recording the program from the user (Fig. 5, Col. 6, lines 39-49, the server 15 receives the request for recording 73 from the user); and a recording instructing unit which instructs a recording of the program recording according to the recording request (the server 15 compares the recording request time with the current time and when the time for recording the desired program is reached, the server 15 controls the recording devices 23-27 to commence recording), but, Mizutani fails to particularly teach that the system includes a capturing unit which captures at least one scene of the program according to the confirmation request and an image transmission processor which transmits a thus captured image to a terminal of the user.

In an analogous art, Girard et al. teaches a system with a capturing unit which captures at least one scene of the program according to the confirmation request and an image transmission processor which transmits a thus captured image to a terminal of the user (Col. 6, line 8-45, Girard et al. teaches that in the interactive television system,

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a user can scroll up and down on a program grid that is currently broadcast. The user can then select a certain program, then at least one frame of the video is sent to the specific user's television to be displayed).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the capturing and image transmission unit as taught by Girard et al. into the remote accessible programming as taught by Mizutani to improve visual and hence correct identification of scheduled broadcast programs that have remotely requested to be recorded. This remedies the situation where incorrect EPG titles have been appended to broadcast programs, and hence incorrect programs of choice are recorded due to the lack of visual verification.

3. **Claims 2, 3, 5, 6, and 10-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani (US 7,028,329), in view of Girard et al. (US 5,571,282), and further in view of Trovato et al. (US 6,445,306).

Regarding claim 2, Mizutani teaches a remote accessible programming system Which teaches a confirmation request receiving unit, which receives a request for confirmation of contents of a program this is being broadcast, from a remote user (Figs. 1-7, col. 5, lines 34 - col. 7, line 3, recites wherein a remote user is able to retrieve a list of scheduled broadcast programs from the server 15); a recording request receiving unit which receives a request for recording the program from the user (Fig. 5, Col. 6, lines 39-49, the server 15 receives the request for recording 73 from the user); and a recording instructing unit which instructs a recording of the program recording according

to the recording request (the server 15 compares the recording request time with the current time and when the time for recording the desired program is reached, the server 15 controls the recording devices 23-27 to commence recording), but, Mizutani fails to particularly teach that the system with an electronic program guide (EPG) storage which stores an extended EPG formed by adding to an EPG a guide image indicating contents of a program and an image transmission processor which transmits the thus acquired image to a terminal of the user.

In an analogous art, Girard et al. teaches a system with an image transmission processor which transmits a thus captured image to a terminal of the user (Col. 6, line 8-45, Girard et al. teaches that in the interactive television system, a user can scroll up and down on a program grid that is currently broadcast. The user can then select a certain program, then at least one frame of the video is sent to the specific user's television to be displayed). Girard et al. teaches an EPG storage (Fig. 5-8), but fails to teach that the image sent to the remote user is an image from the extended EPG.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the image transmission unit as taught by Girard et al. into the remote accessible programming as taught by Mizutani to improve visual and hence correct identification of scheduled broadcast programs that have remotely requested to be recorded. This remedies the situation where incorrect EPG titles have been appended to broadcast programs, and hence incorrect programs of choice are recorded due to the lack of visual verification.

The proposed combination of Mizutani and Girard et al. teaches all the limitations as disclosed above, but fails to teach that the image sent to the remote user is an image from the extended EPG.

In an analogous art, Trovato et al. teaches a system which has a program guide transferred to the user, wherein the an image within the program guide for each broadcast program is available (col. 9, line 66- col. 11, line 17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the EPG guide image as taught by Trovato into the proposed combination of Mizutani and Girard et al. to improve visual and hence correct identification of scheduled broadcast programs that have remotely requested to be recorded. This remedies the situation where incorrect EPG titles have been appended to broadcast programs, and hence incorrect programs of choice are recorded due to the lack of visual verification.

Regarding claim 3, the proposed combination of Mizutani, Girard et al., and Trovato et al. recites all the limitations as discussed in claim 2 above, and furthermore Girard et al. teaches (Col. 6, line 8-45, Girard et al. teaches that in the interactive television system, a user can scroll up and down on a program grid that is currently broadcast. The user can then select a certain program, then at least one frame of the video is sent to the specific user's television to be displayed).

Regarding claim 5 and 6, the proposed combination of Mizutani, Girard et al., and Trovato et al. teaches all the limitations as discussed in claim 2 above, Official Notice is taken that CGI and HTML are well known and old in the art to be used as a

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standard for interfacing external applications (including an apparatus) with information servers on a local area network connected to the world wide web. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use CGI and HTML into the proposed combination of Mizutani, Girard et al. and Trovato et al. to allow a globally accepted format and markup language thereby increasing the user's accessibility of the programmed recording capabilities of the system.

Method claim 10 is rejected for the same reasons as discussed in system claim 2 above.

Method claim 11 is rejected for the same reasons as discussed in system claim 3 above.

Method claim 12 is rejected for the same reasons as discussed in system claim 4 above.

4. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani (US 7,028,329), in view of Girard et al. (US 5,571,282), further in view of Trovato et al. (US 6,445,306), and further in view of Asamura (JP02000341600A).

Claim 4 is rejected for the same reasons as discussed above in claim 3, but the proposed combination of Mizutani, Girard et al., and Trovato et al. fails to teach that the EPG guide image is acquired and transmitted to the user.

In an analogous art, Asamura teaches that during a commercial message, the system automatically displays the EPG to the user (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically display the EPG to the user as taught by Asamura into the proposed combination of Mizutani, Girard et al., and Trovato et al. so that the user can watch another desired program by being automatically given a choice to tune to another channel during a commercial break.

5. **Claim 7, 13, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani (US 7,028,329) in view of Girard et al. (US 5,571,282), and further in view of Browne (WO 92/22983).

Claim 7 is rejected for the same reasons as discussed in claim 1 above, but the proposed combination of Mizutani and Girard et al. fail to particularly teach that a recording unit includes a free-run recording unit which records a program being broadcast continuously in an endless manner; and a program storage which stores a program, from a start point of the program retroactively, whose recording has been instructed.

In an analogous art, Browne teaches a large capacity, random access, multi-source recorder that teaches a recording unit including a free-run recording unit which records a program being broadcast continuously in an endless manner (Pg. 19, line 6-18, and pg. 7, line 20- pg 8, line 23 teaches a FIFO recorder that continuously records a program, even records over material that have been previously recorded in the case that storage capacity has run out); and a program storage which stores a program, from a start point of the program retroactively, whose recording has been instructed (Pg. 8,

line 6-23 discloses wherein a program is recorded retroactively from the beginning of the broadcast time).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the free-run and program storage recording capabilities as taught by Browne into the proposed combination of Mizutani, and Girard et al., so that in the case of a live sports broadcast where a game goes into overtime or extra innings, the free-run recording option allows the user to not miss any desired portion not foreseen in a prescheduled EPG. In the case of the program storage option, it allows users to not miss an entire show even though the user programs the system a certain amount of time after the beginning of the broadcast program.

Regarding claim 13, Mizutani, Girard et al., and Browne disclose the limitations as discussed in claims 1 and 7, above, except a capturing is located in the recording unit. In the rejection of this claim, the examiner intends to include the capturing unit in the recording unit.

Regarding claim 14, the systems of Mizutani, Girard et al., and Browne as discussed above in claims 1, 7 and 13 can be incorporated into a single system.

6. **Claims 8, 9, 15, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani (US 7,028,329), in view of Girard et al. (US 5,571,282), in view of Trovato et al. (US 6,445,306), and further in view of Browne (WO 92/22983).

Claim 8 is rejected for the same reasons as discussed in claim 2 above, but the proposed combination of Mizutani, Girard et al., and Trovato et al. fails to particularly

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teach that a recording unit includes a free-run recording unit which records a program being broadcast continuously in an endless manner; and a program storage which stores a program, from a start point of the program retroactively, whose recording has been instructed.

In an analogous art, Browne teaches a large capacity, random access, multi-source recorder that teaches a recording unit including a free-run recording unit which records a program being broadcast continuously in an endless manner (Pg. 19, line 6-18, and pg. 7, line 20- pg 8, line 23 teaches a FIFO recorder that continuously records a program, even records over material that have been previously recorded in the case that storage capacity has run out); and a program storage which stores a program, from a start point of the program retroactively, whose recording has been instructed (Pg. 8, line 6-23 discloses wherein a program is recorded retroactively from the beginning of the broadcast time).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the free-run and program storage recording capabilities as taught by Browne into the proposed combination of Mizutani, and Girard et al., so that in the case of a live sports broadcast where a game goes into overtime or extra innings, the free-run recording option allows the user to not miss any desired portion not foreseen in a prescheduled EPG. In the case of the program storage option, it allows users to not miss an entire show even though the user programs the system a certain amount of time after the beginning of the broadcast program.

Claim 9 is rejected for the same reasons as discussed in claim 3 above, but the proposed combination of Mizutani, Girard et al., and Trovato et al. fails to particularly teach that a recording unit includes a free-run recording unit which records a program being broadcast continuously in an endless manner; and a program storage which stores a program, from a start point of the program retroactively, whose recording has been instructed.

In an analogous art, Browne teaches a large capacity, random access, multi-source recorder that teaches a recording unit including a free-run recording unit which records a program being broadcast continuously in an endless manner (Pg. 19, line 6-18, and pg. 7, line 20- pg 8, line 23 teaches a FIFO recorder that continuously records a program, even records over material that have been previously recorded in the case that storage capacity has run out); and a program storage which stores a program, from a start point of the program retroactively, whose recording has been instructed (Pg. 8, line 6-23 discloses wherein a program is recorded retroactively from the beginning of the broadcast time).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the free-run and program storage recording capabilities as taught by Browne into the proposed combination of Mizutani, and Girard et al., so that in the case of a live sports broadcast where a game goes into overtime or extra innings, the free-run recording option allows the user to not miss any desired portion not foreseen in a prescheduled EPG. In the case of the program storage option,

it allows users to not miss an entire show even though the user programs the system a certain amount of time after the beginning of the broadcast program.

Regarding claim 15, Mizutani, Girard et al., Trovato et al. and Browne disclose the limitations as discussed in claims 2 and 8, above, except a capturing is located in the recording unit. In the rejection of this claim, the examiner intends to include the capturing unit in the recording unit.

Regarding claim 16, the systems of Mizutani, Girard et al., Trovato et al. and Browne as discussed above in claims 2, 8 and 15 can be incorporated into a single system.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

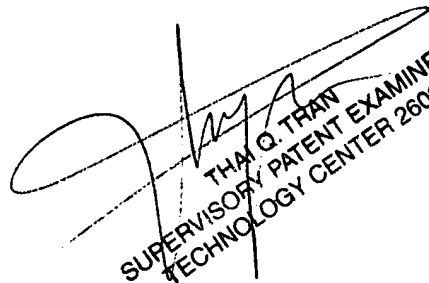
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GT
11/16/2006


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